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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

SHAY, DAVID M

ART UNIT PAPER NUMBER

3739

DATE MAILED: 09/22/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/855,012

Applicant(s)

Shokorhi

Examiner

J. Shary

Group Art Unit

3739

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on July 7, 2003.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 2-6, 10, 11, + 14-27 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 2-6, 10, 11, + 14-27 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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The amendment filed July 7, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: a focused light source.

Applicant is required to cancel the new matter in the reply to this Office Action.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2-6, 10, 11, and 20-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The originally filed disclosure is silent with regard to a focused light source.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 2-6, 14-19, and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In claim 20 the exact meaning of the term "to define a target point, wherein said light source directs a receptor at said target" point is unclear. In claim 19, it is unclear what further step is intended to be claimed since any device is able to be disposed of and is thus "disposable". Claim 14 is incomplete as no surgical step is recited.

The indicated allowability of claims 14-19 and 27 is withdrawn in view of the newly discovered reference(s) to Marshall. Rejections based on the newly cited reference(s) follow.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 14, 16, 17, and 19 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Marshall.

Marshall teaches a device as claimed (see Figures 1 and 5) to be used in the claimed manner (see column 2 lines 39-64 and column 3, line 35 – column 5, line 66) and further discusses the usefulness of the device for surgery (see column 1, lines 38-44) and the use of a battery (see column 6, lines 14 to 20).

Claims 14, 15 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall in combination with Chen et al ('340). Marshall teaches methods as claimed except the use of tape and the particular material making up the device. Chen et al ('340) teach the

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equivalence of using adhesive tape and a strap to secure a covering to the skin and to fabricate such coverings from plastic. It would have been obvious to the artisan of ordinary skill to employ adhesive tape in place of the strap of Marshall et al since this is equivalent to a strap as taught by Chen et al ('340) and to form the device of Marshall from paper or plastic, since this is an appropriate material for a shield, as also taught by Chen et al, thus producing a method such as claimed.

Claims 2-6, 10, 11, and 20-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall in combination with Unger et al and Chen et al ('340). Marshall teaches a device as claimed wherein the battery is mounted to the device via the cord, except for the express teachings of a focused source, a tear drop shape, and forming the device of plastic. Chen et al ('340) teach the equivalence of straps and adhesive for attaching a shield to the skin and forming such shields from plastic. Unger et al teach that illuminating divides are typically packaged with lenses. It would have been obvious to the artisan of ordinary skill to employ a focused light source, since lenses are typically included with divides and since if the light sources of Marshall were not focused, they would output light over a larger area, and thus be less effective in causing the eye to be directed at a particular point, and to employ an adhesive to perform the function of the strap of Marshall as shown in Figure 3 thereof since these are equivalents for attaching to skin as shown by Chen and wherein the strap is a substantially planar portion, thus producing a device such as claimed.

Claims 14 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall in combination with Swinger et al. Marshall teaches a method as claimed, but do not discuss cataract surgery specifically. Swinger et al teach controlling the position of the eye

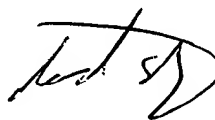
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during cataract surgery. It would have been obvious to the artisan of ordinary skill to perform cataract surgery as taught by Swinger et al in the method of Marshall, since slit lamps are employed for this surgery, as taught by Swinger et al, or alternatively to employ the eye positioning method of Marshall to position the eye in the method of Swinger et al, since Swinger et al discuss no particular method for achieving the eye positioning, thus producing a method such as claimed.

Any inquiry concerning this communication should be directed to David Shay at telephone number 308-2215.

Shay/DL

August 27, 2003

A handwritten signature in black ink, appearing to read 'David M. Shay' in a stylized, cursive script.

DAVID M. SHAY
PRIMARY EXAMINER
GROUP 330